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Remark:

Claims 1, 6-18, 40 and 49 were rejected under 35 U.S.C. 103(a) as unpatentable over Spackova et al. in view of Powell.

Independent claim 40:

A telephone interview had been conducted on 10/30/2007 to discuss in great detail how the examiner interprets the prior arts Spackova and Powell to read or teach the limitations of claim 40. An interview summary mutually agreed by the examiner and the applicant was also filed on 10/30/2007. Hereby the applicant wishes to express his most sincere thanks for the examiner to provide a clear picture how the ground of rejection was derived.

Listed below are the three limitations recited by claim 40:

- (1) defining m different physical dimensional parameters of said human body;
- (2) measuring each of said m defined parameters a physical dimension of said body to produce m values; and
- (3) processing said m values to produce a multiple digits compressed BP code for representing said m values.

According to the office action and the interview, limitations (1) and (2) are provided by the Spackova and limitation (3) is either provided by Powell or quoted by an official notice as an old expedient in the art. The applicant had studied the abstract of Powell several times. Listed below is the wording of the abstract that was referred by the examiner to teach the limitation of compressing different parameter values to form a compressed code:

The system includes a personal computer (PC) having hardware and software for receiving an electronics coupon from the system of computer networks, translating the received coupon into a binary format, and sending the binary-formatted coupon to a card writing device.

Careful review of this disclosure quoted by the examiner during the interview did not show any trace that Powell did teach the limitation of compressing m values of different physical dimensional parameters into a compressed BP code. However, it is true that with proper hardware and software (not the software of Powell which was provided for

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translating the received coupon into binary format), a PC can perform the job of compressing m pieces of data into a compressed code, if there is a desire to do so.

According to the interview, the examiner agreed that Spackova did not explicitly disclosed the step to define m different physical dimensional parameters. Spackova did not explicitly disclosed the names of the parameters defined. Spackova also did not explicitly disclose a step to measure the m parameters of the body. However, the systems of Spackova allows a person to define two or more different parameters (e.g. distances between 72, 74 and 72, 75 of FIG. 3 is desired. The systems of Spackova allows people to assign names to each of the distances 72, 74 and 72, 75. The system of Spackova also allows the distances 72, 74 and 72, 75 to be measured. According to the interview, the examiner agreed that Powell did not explicitly disclose the process of compressing m measured data to form a code. However, the system of Powell as disclosed in the abstract allows data to be compressed if desired. The examiner also took official notice that compressing data is an old expedient in the art.

In summary, according to the examiner, Spackova and Powell did not explicitly disclosed the act to define m physical dimensional parameters, nor disclosed the act to give each physical dimensional parameter a name, nor disclosed the act to measure the dimension of each parameters to give m values, nor disclosed the act to compress said m values into one compressed code. However, the system of Spackova and Powell combined allow each claim limitation to be performed if there is a desire to do so. Accordingly when there is a desire to define m different physical dimensional parameters (such as neck diameter, sleeve length); a desire to measure each of these m different physical dimensional parameters to produce m values (neck diameter =16 inches, sleeve length = 28 inches), a desire to compressed the 16 inches neck diameter and 28 inches sleeve length into one compressed BP code (so as to have a BP code that can be easily portable, allowing a lady to buy a fitted shirt for her husband), then the systems of Spackova and Powell combined will be able to perform the claimed job.

The above analysis is true except two additional requirements are needed by patent rules to justify a rejection of claim 40 under 35 U.S.C. 103(a).

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Requirement #1

The first requirement is to proof that the following 3 motives are derived from the prior art, and not from the disclosure subject application:

- (1) the motive why the m different physical dimensional parameters (each comes with a name) should be defined in the system of Spackova;
- (2) the motive why Spackova has a desire for each of the m different physical dimensional parameters defined to be measured to produce m values;
- (3) the motive why Spackova has a desire to combine with the system of Powell to compress the m measured values into a BP code that represents the dimensions of the m different physical dimensional parameters measured.

These motives should come from the cited prior art Spackova and Powell, and should not be derived from the disclosure of the subject application. If the ground of rejection of claim 40 is to be withheld, the examiner is respectfully to indicate the rational how these three motives were reasonably derived from the disclosure of Speckova and Powell.

Requirement #2

The examiner is respectfully requested to pay attention to the detail wording of limitation (3). Limitation (3) of claim 40 did not simply recite an ordinary method of compression. Claim 40 recited a compression method that compressed "m" measured "dimensional values" to form "one" "compressed BP code". Careful review of the abstract of Powell as indicated by the examiner during the interview and as shown in page 3 of this response did not show any trace of claim limitation (3). The applicant had also conducted a word search and inform the examiner during the interview that Powell did not even mentioned the words "compression", "compressed..."etc. It is obvious that Powell did not disclose nor teach the limitation (3) of claim 40. Since the disclosure of Powell failed to teach limitation (3), the discussion of the teaching of compression is now directed to the official notice of the office action that compression of data is an old expedient in the art. Without Powell, the ground of rejection of claim 40 now becomes a rejection under 35 U.S.C. 103(a) as anticipated by Speckova further taking into the account of the official notice that compression of data is an old expedient in the art.

The examiner is respectfully requested to review page 2, bottom paragraph to page 3, line 7 of the office action dated 01/23/2006. According to this section of the office action,

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claim 40 was rejected under 35 U.S.C. 103(a) as anticipated by Speckova, taking into account the official notice that use of compressed data is an old expedient in the art. It is obvious that the ground of rejection for claim 40 now goes back to the situation of the office action dated 01/23/2006. The applicant understands that the examiner of this application is now handled by a different examiner, so it is not a surprise for a new examiner to return to an old ground of rejection that had been overcome.

The applicant sincerely wishes to submit a brief summary of past history about the prosecution of the subject application as follow, so as to facilitate the new examiner to complete the examination job:

- (1) The main independent claim 40 of the subject application is substantially identical to main claim 1 of the sister application 10/193,838 filed 07/12/2002, now issued as US Patent 7,194,327. The sister application 7,194,327 had been examined for about five years by examiner Mr. Peter Nerbun before it was allowed and issued.
- (2) The subject application had been examined by the previous examiner Mr. Joseph Fischetti since 08/15/2001. According to the record of the applicant, there had been several rounds of search and 6 rounds of office actions between the applicant and the previous examiner, Mr. Fischetti during the past 6 years.
- (3) It means claim 40, without modification had survived serious scrutiny by two different examiners, who cited different prior arts. Each examiner had spent around 5 years in prosecuting the examination of the same independent claim.
- (4) The prosecution of the subject claim 40 now goes back to the position of the office action dated 01/23/2006, a rejection under 35 U.S.C. 103(a) as anticipated by Spackova further in view of the official notice about the old expedient art of compressed data.
- (5) Because of the very special nature of the compressed technology used – to compress "m different dimensional measurements" into "one compressed BP code", the applicant quoted 37 CFR 1.107 (b) and precedent court ruling *In re Sun*, 31 USPQ 2d 1451, 1455 (Fed. Cir. 1993) demanding examiner Fischetti to provide reference that teaches the specific compressed technology.

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- (6) In response to the request of the applicant, Examiner Fischetti cited Runton as a ground to support the compression feature.
- (7) Although Runton is a much closer art than Powell to teach compression technology, the applicant was successful to proof that Runton did not disclose, nor teach the very special compression technology claimed by claim 40.

Although this application is now handled by a different examiner, the FACT that the ground of rejection as anticipated by Speckova in view of the official notice about the old expedient art of compressed data, had been overcome and become established record. This official established prosecution record should not be revisited unless there is strong evidence that it is required.

The ground of rejection as anticipated by Speckova in view of Runton, which is a much closer prior art reference than Powell (for the teaching of compression technology) had been successfully overcome. Accordingly the ground of rejection as anticipated by Speckova in view of Powell (a more distant reference than Runton), further in view of the discussion of Powell in page 3 of this response is respectfully requested to be withdrawn.

Claims 1, 6-18 and 49:

Claims 1, 6-18 and 49 had been rejected under 35 U.S.C. 103(a) as anticipated by Spackova further in view of Powell. There are two major concerns:

(1) Powell did not disclose any compression technology.

During the interview dated 10/30/2007, the examiner agrees that Powell was about packet – data format of network. The examiner agreed that did not explicitly disclose any compression technology, only the system of Powell (a PC) may be used to service the job of data compression. In fact, any computer in the field is capable to service data compression if supplied with proper software. The question here is if Powell did provide motive and teaching to compress the special m values of claim 40 into one compressed BP code? Claim 6 further require Powell to demonstrate another very special format of compression – a primary “compressed n1 digits code” and a “supplemental n2 digits code”,

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both provided together "for representing said m values". Since Powell did not mention any thing related to compression at all, obviously this further special compression characteristics claimed is not found nor taught by Powell.

(2) Official notice about the limitations of claims 1, 6-18, 49:

Without cited prior art to support the rejection of additional characteristics recited in depending claims 1, 6-18, 49, it seems the office action took the official notice that the additional limitation claimed by dependent claims 1, 6-18, 49 are either can be used for a variety of application, or a matter of design choice, and therefore obvious to one skill in the art. The motive of design choice quoted by the office action actually derived from the disclosure of the subject application, and not from Spackova or Powell to justify a rejection under 35 U.S.C. 103(a). The examiner is respectfully requested to show how the motive of design choice quoted by the office action is disclosed or taught by the cited prior art. In case the motive to show the claimed limitations is derived from an official notice, not supported by a prior art, the examiner is respectfully requested to supply supporting prior art according to the following patent rule and precedent court ruling:

Listed below is a quotation of a precedent court case *In re Sun*, 31 USPQ 2d 1451, 1455 (Fed. Cir. 1993),

Finally, appellants seemingly argue that the examiner's lack of citation to support the asserted level of skill in the art makes the rejections improper per se. This is so, appellants suggest, because without such citation, there is no record by which they can argue that the examiner erred.

The following is a quotation from 37 C.F.R. 1.107(b):

When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.

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Accordingly, applicant courteously requested that if the rejection is maintained, the examiner either provides reference for each claim limitation as disclosed in a prior art, or alternately provides an affidavit under 37 C.F.R. 1.107 (b) providing citation regarding level of skill in the art and why it is appropriate to take the "Official Notice" stated to support the rejection of the additional limitations claimed by dependent claims 1, 6-18 and 49.

(End of remark)

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